IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| | | | |
|---|---|---|---|
| Application No. | : 10/071,196 | Confirmation No. | : 2937 |
| First Named Inventor | : Toshihiro Takagi | | |
| Filed | : February 11, 2002 | | |
| TC/A.U. | : 2623 | | |
| Examiner | : Timothy R. Newlin | | |
| Docket No. | : 010482.50912US | | |
| Customer No. | : 23911 | | |
| Title | : Broadcasting Receiver Having Operation Mode Selection Function | | |

**AFTER FINAL REQUEST FOR RECONSIDERATION**

**Mail Stop AF**
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In complete response to the final Office Action dated February 15, 2008, reconsideration and allowance of the above-identified application are respectfully requested. Claims 1-13 remain pending.

Claims 1, 5, 7, 8 and 13 are rejected as being anticipated under 35 U.S.C. §102(e) by U.S. Patent No. 6,530,083 to Liebenow ("Liebenow").[1] This ground of rejection is respectfully traversed.

Applicants' claim 1 recites a receiver that includes an input device that "has a numeral inputting key for inputting a numeral when the operation mode is selected." The receiver is arranged such that "when the user has operated the numeral inputting key to enter the selection number and the numeral inputting key does not coincide with a channel number stored in the memory, the control

[1] Although claims 7, 8 and 13 are not listed in the header of the rejection, it is believed that these claims are subject to this rejection because the claims are addressed in the body of the rejection.

unit refers to the memory to select the operation mode that corresponds to the selection number thus entered."

In contrast to Applicants' claim 1, which involves a numeral inputting key to select an operation mode, Liebenow provides a user interface that allows a user to select an identity (1) from a list of users, (2) by entering the users name via a keyboard or (3) by using switches that are apparently dedicated to selecting user identities (e.g., a switch labeled USER 1).[2]

Liebenow, however, does not disclose that an input from any of the identity selection mechanisms is compared to a channel number in memory. Furthermore, none of these channel selection mechanisms involves the use of a numeral inputting key to enter a selection number.

**Liebenow Does Not Disclose a Comparison of Inputs from the Keyboard or Switches with a Channel Number Stored in Memory**

Applicants' claim 1 recites that the control unit refers to the memory to select the operation mode "when the user has operated the numeral inputting key to enter the selection number and the numeral inputting key does not coincide with a channel number stored in the memory." Liebenow does not disclose such a comparison.

[2] Col. 8, lines 20-29.

The Response to Arguments section relies upon the keyboard input or the depression of switches of Liebenow as corresponding to the claimed "numeral inputting key." Liebenow does not disclose that as part of the identity selection, the input from the keyboard or by depression of a switch is compared with a channel number in memory.

It appears that the rejection of the claim recitation of "the numeral inputting key does not coincide with a channel number stored in the memory" is based on the fact that nothing about the keyboard input or the depression of a switch disclosed by Liebenow has any relation to a channel stored in a memory. This is not a proper reading of Applicants' claim 1. Specifically, this claim recites that the control unit refers to the memory to select the operation mode "when the user has operated the numeral inputting key to enter the selection number and the numeral inputting key does not coincide with a channel number stored in the memory." This requires a comparison of the input of the numeral operating key and a channel number stored in memory. Such a disclosure is not found in Liebenow.

**Liebenow Does Not Expressly or Inherently Disclose Using a Keyboard to Operate a Numeral Inputting Key to Enter a Selection Number**

The Response to Arguments section of the Office Action states that the use of the keyboard of Liebenow anticipates the claimed use of numeral inputting keys. Applicants' claim 1 recites that "the user has operated the numeral

inputting key to enter the selection number." In contrast, Liebenow discloses that the keyboard allows "the user to enter his or her identity (or the identity of his or her group" by typing it into the system."[3] Liebenow discloses a number of different user identities, such as "Jane", "John", "Smith Family", "Children", USER 1" or "USER 2".[4] However, typing out any of these user identities would not involve operating "a numeral inputting key to enter a selection *number*."[5] Instead, these would only involve possibly entering a number of letters followed by a single number "1" or "2". This would be performed to enter a selection (i.e., a selection corresponding to the exact phrase typed by the user), and not a selection number.

It should be recognized that claim 1 is rejected for anticipation, which requires an express or inherent disclosure of every claim element. Unlike obviousness, inherency "may not be established by probabilities or possibilities."[6] Instead, inherency requires that "the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.'"[7] Thus, in view of the absence of a disclosure in Liebenow of using a keyboard to enter a numeral inputting key to enter a "selection number", the use of the

[3] Col. 8, lines 22-24.
[4] Col. 8, lines 1-3.
[5] *Emphasis added.*
[6] M.P.E.P. § 2112 IV, citing *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).
[7] *Id.*

keyboard as disclosed in Liebenow does not expressly or inherently disclose that "the user has operated the numeral inputting key to enter the selection number."

**The Switches of Liebenow are not Numeral Inputting Keys**

The Response to Arguments section also relies on the switches labeled "USER 1" and "USER 2" as anticipating the claimed numeral inputting keys. These keys are depressed to select an identity. Similar to the discussion above with regard to the keyboard, Liebenow does not disclose that the switches are employed "to enter a selection number." Instead, it appears that the switches are merely employed to enter a selection.

**The Rejection of Claim 7 is Legally Improper**

Claim 7 is rejected for anticipation, which as discussed above, requires an express or inherent disclosure of every claim element. The Office Action acknowledges that Liebenow does not explicitly disclose the use of the numerical inputting key in the manner recited in 7, and instead takes "Official Notice" that what is recited in that claim is "a fundamental and *obvious* technique."[8] Official Notice is discussed in M.P.E.P. § 2144.03. This section of the M.P.E.P. relates to obviousness rejections, and not anticipation rejections. There is nothing in the M.P.E.P., statute, rules or case law holding that it is proper to take Official Notice in an anticipation rejection. Thus, the rejection of claim 7 is legally improper.

[8] Final Office Action, at paragraph 5, (emphasis added).

**The Rejection of Claim 7 is Factually Improper**

Claim 7 depends from claim 1. Accordingly, the combination of these claims recites

> when the user has operated the numeral inputting key to enter the selection number and the numeral inputting key does not coincide with a channel number stored in the memory, the control unit refers to the memory to select the operation mode that corresponds to the selection number thus entered; and
>
> when the numeral inputting key coincides with a channel number stored in the memory, the control unit causes a tuner to receive a channel corresponding to the channel number is selected.

Thus, anticipation of claim 7 requires a comparison of inputs from numeral inputting keys against channel numbers stored in memory, and then either an operation mode is selected or the tuner receives the channel corresponding to the channel number based upon whether the numeral inputting key coincides with a channel number stored in memory.

As discussed above, Liebenow does not expressly or inherently disclose a comparison of the input from the keyboard or from the switch with a channel number stored in memory. Thus, Liebenow cannot expressly or inherently disclose that the input from the keyboard or switch is used to determine whether to either select an operation mode or a channel number in the manner recited in claim 7.

**Liebenow Does Not Disclose Using an Input Pattern of a Numeral Inputting Key to Select an Operation Mode**

Applicants' claim 5 recites a control unit that "assigns a predetermined input pattern by use of the numeral inputting key to the operation mode." When "the user operates the numeral inputting key in the input pattern, refers to the memory to select the operation mode that corresponds to the input pattern."

The rejection of claim 5 relies upon the depression of the "User 1" switch once as the claimed input pattern. The Response to Arguments section of the Office Action cites to a dictionary definition to support the position that a single button press can be considered a pattern. It is respectfully submitted that this is not a proper interpretation of the term "pattern".

Although during examination claims are given their broadest reasonable interpretation, this interpretation is not performed in a vacuum. Instead, the Patent Office "determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction 'in light of the specification as it would be interpreted by one of ordinary skill in the art.'"[9] Accordingly, Applicants' specification should be consulted first when determining the definition of the term "pattern". Applicants' specification, at page 16, lines 5-7, discussed two exemplary input patterns "555" and "777". Here, Applicants' are not arguing that only these disclosed input patterns are covered by the claims. Instead, Applicants' are

demonstrating that the specification discloses that the term "pattern" should be given its normal meaning of more than one input. Because the rejection of claim 5 relies upon a single input, this rejection should be withdrawn.

Claims 8 and 13 are not anticipated by Liebenow at least by virtue of their dependency from claims 1 and 5.

For at least those reasons set forth above, it is respectfully requested that the rejection of claims 1, 5, 7, 8 and 13 as being anticipated by Liebenow be withdrawn.

Claims 2 and 6 are rejected under 35 U.S.C. § 103(a) as being obvious in view of the combination of Liebenow and U.S. Patent No. 6,177,931 to Alexander et al. ("Alexander"). This ground of rejection is respectfully traversed.

Applicants' claim 2 recites that

> the control unit assigns any one of the direction keys input by the user to the set operation mode and stores the direction key and the operation mode in correlation with each other in the memory and also, when the user presses both the operation key and any one of the direction keys, refers to the memory to select the operation mode that corresponds to the direction key thus pressed by the user.

Similarly, Applicants' claim 6 recites that

[9] M.P.E.P. § 2111, citing *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364(Fed. Cir. 2004).

> the control unit assigns any one of the direction keys to the operation mode and stores the operation mode in correlation with the direction key in the memory and, when the user presses the operation key and also any one of the direction keys, refers to the memory to select the operation mode that corresponds to the direction key thus pressed.

Thus, these claims require the use of an operation key and one of the direction keys to select an operation mode.

The original rejection of these claims relies upon an incorporation of the directional keys of Alexander into the identity selection of Liebenow. In response to this rejection, Applicants' pointed out that Liebenow and Alexander are both silent with respect to the use of two keys to select an operation mode. The Response to Arguments section of the final Office Action now contends, without providing any supporting evidence, that the use of a shift key is a common technique for input devices. Because the rejection is now based upon a position that finds no support in the rejection of record, the Patent Office has not provided sufficient evidence to establish a *prima facie* case of obviousness with respect to these claims.

Furthermore, it is respectfully submitted that in view of the disclosure of Liebenow, one of ordinary skill in the art would not have complicated the identity selection to require the use of two keys to selection an identity. Specifically, Liebenow discloses that one technique for selecting an identity is through the use of a list of known users. This could easily be accomplished using UP and DOWN directional keys of Alexander, without adding the requiring of a

shift key. Thus, if one of ordinary skill in the art were motivated to combine Liebenow and Alexander, the combination would result in the use of directional keys to select identities from a list. Adding a requirement to depress two keys, as is being proposed by the Office Action, would actually complicate the identity selection, and thus would not have been desirable. Accordingly, the rejection of claims 2 and 6 for obviousness in view of the combination of Liebenow and Alexander should be withdrawn.

Claim 3 and 11 are rejected under 35 U.S.C. § 103(a) as being obvious in view of the combination of Liebenow and U.S. Patent No. 5,644,354 to Thompson et al. ("Thompson"). This ground of rejection is respectfully traversed.

Applicants' claim 3 recites that "when the user operates the numeral inputting key to hold the numeral key corresponding to the selection number pressed for at least a predetermined time, refers to the memory to select the operation mode that corresponds to the selection number thus entered."

The Response to Arguments section of the final Office Action states that Liebenow is being relied upon for the disclosure of an operation mode selection, and Thompson for holding a button for a predetermined amount of time. The Office Action concludes that incorporating a function of holding a button for a predetermined amount of time into the identity selection of Liebenow would "provide added functionality to the user interface without increasing the number of buttons."

As discussed above with regard to claims 2 and 6, one technique for increasing the functionality without increasing the number of buttons would be to use the directional arrows of Alexander to select an identity from the list of Liebenow. Another technique is expressly disclosed by Liebenow, namely using a keyboard. Thus, the combination of Liebenow and Thompson proposed by the Office Action would result in a less desirable system which requires a complicated process of holding buttons for a period of time, instead of the much simpler technique expressly disclosed by Liebenow, or disclosed in the combination of Liebenow and Thompson.

Accordingly, it is respectfully submitted that one of ordinary skill in the art would not have been motivated to modify Liebenow in the manner described in the Office Action, and the rejection of claim 3 should be withdrawn.

Claim 11 is patentably distinguishable over the combination of Liebenow and Thompson due to its dependency from claim 3.

For at least those reasons set forth above, it is respectfully requested that the rejection of claims 3 and 11 as being obvious in view of the combination of Liebenow and Thompson be withdrawn.

Claims 4 and 12 are rejected under 35 U.S.C. § 103(a) as being obvious in view of the combination of Liebenow and U.S. Patent No. 7,149,969 Thrane ("Thrane"). This ground of rejection is respectfully traversed.

Claim 4 depends from claim 1 and claim 12 depends from claim 5. As discussed above, Liebenow does not disclose or suggest all of the elements of claims 1 and 5. It is respectfully submitted that Thrane does not remedy these deficiencies of Liebenow. Accordingly, the combination cannot render claims 1 and 5, and in turn dependent claims 4 and 12, obvious.

Claim 9 was rejected as being obvious over Liebenow, Alexander and Thrane. Claim 10 was rejected as being obvious over Liebenow, Thompson and Thrane. These grounds of rejection are respectfully traversed.

Claims 9 and 10 respectively depend from claims 2 and 3. As discussed above, the combination of Liebenow and Alexander does not render claim 2 obvious, and the combination of Liebenow and Thompson does not render claim 3 obvious. It is respectfully submitted that Thrane does not remedy these deficiencies of the combinations of Liebenow and Alexander or Liebenow and Thompson. Accordingly, claims 9 and 10 are patentably distinguishable from the rejections of record at least by virtue of their dependency from claims 2 and 3.

If there are any questions regarding this response or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1323 (Docket # 038819.59012US).

Respectfully submitted,

May 12, 2008

Stephen W. Palan
Registration No. 43,420

CROWELL & MORING, LLP
Intellectual Property Group
P.O. Box 14300
Washington, DC 20044-4300
Telephone No.: (202) 624-2500
Facsimile No.: (202) 628-8844
SWP:crr
*5765149*